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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,744	12/20/2001	Joseph C. Walsh	PP 5.71(c)	4239

7590

05/28/2003

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EXAMINER

TAWFIK, SAMEH

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 05/28/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

**Office Action Summary**

Application No.

10/027,744

Applicant(s)

WALSH, JOSEPH C.

Examiner

Sameh H. Tawfik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 April 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-94 is/are pending in the application.
- 4a) Of the above claim(s) 29-94 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Invention I (claims 20-28) in Paper No. 7 is acknowledged. The traversal is on the ground(s) that claims 36-94 are identical to claims 1-59 of issued U.S. Patent No. 6,213,388. therefore, has already taken the position that these claims are not properly restrictable since they all appear in a single issued patent and the search. This is not found persuasive because the examiner believes that each new case is different when it comes to restriction as noted by the MPEP 706.04 and as the applicant admitted it the examiner needs to refer back to the parent case only for search and rejection. The examiner believes searching for all different groups will burden the examiner for the reasons provided in the restriction as disclosed in paper No. 5.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In (claim 21, lines 2-4) "...said pour spout means front panel further comprises a lamination of a paperboard material and a plastic material." is vague, indefinite, and/or confusingly worded because it is not clear what applicant is referring to; etc.

### ***Claim Rejections - 35 USC § 102***

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Nerenberg et al.

(2,820,585).

§ 2  
comprising

Nerenberg discloses a process for making a dispensing assembly comprising the steps of providing carton means (1) having a dispensing opening (U shaped 4) in a side wall (2) thereof, pour spout means (6) mounted in the dispensing opening and including a front panel and separate liner means in the carton (liner 10); bonding the liner means to the front panel whereby upon initial opening of the pour spout means that portion of the liner bonded to the front panel separates from the liner means providing access to the interior thereof, see for example (Figs. 3, 5, and 7).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21, 22, 24, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nerenberg et al. (2,820,585) in view of Sternau (3,605,578).

Nerenberg does not disclose that “the pour spout means front panel further comprises a lamination of a paperboard material and a plastic material”. However, Sternau discloses a

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similar method for making a dispensing assembly comprising the pour spout means front panel further comprises a lamination of a paperboard material and a plastic material (column 2, lines 35 and 36) wherein the coating layer comprises polyethylene (column 2, line 45); the pour spout comprises a first wing portion and a second wing portion (Figs. 5 and 11) wherein the first wing portion is attached to the front panel at a first fold line and the second wing portion is attached to the front panel at a second fold line, see for example (Figs. 5 and 11).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Nerenberg's method by having the pour spout means front panel further comprises a lamination of a paperboard material and a plastic material wherein the coating layer comprises polyethylene and the pour spout comprises a first wing portion and a second wing portion wherein the first wing portion is attached to the front panel at a first fold line and the second wing portion is attached to the front panel at a second fold line, as suggested by Sternau, in order to avoid undesired sifting of material from boxes and simplify manufacturing procedure for the boxes and to minimize the effort to open the spout and to minimize the strain of the tab (column 1, lines 45-49).

Regarding claim 22: Nerenberg nor Sternau disclose the plastic material comprises a polyester material. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Nernberg's method by having the plastic material comprises a polyester material, as a matter of engineering design choice, since the examiner takes an official notice that the mentioned plastic material comprises a polyester material, is old, well known, and available in the art.

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Claims 23, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 21 above, and further in view of Knauf (5,415,910).

Nerenberg nor Nerenberg disclose the step of bonding the liner means to the front panel comprises bonding the liner means to the coating layer nor forming at least one cut line in the layer. However, Knauf discloses a similar method of making a container comprising the step of bonding the liner means to the front panel comprises bonding the liner means to the coating layer and forming at least one cut line in the layer, see for example (Figs. 5 and 11).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Nerenberg's method by having the step of bonding the liner means to the front panel comprises bonding the liner means to the coating layer and forming at least one cut line in the layer, as suggested by Knauf, in order to provide an improved inner liner for a container for dough and similar products (column 3, lines 26-29).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Walsh 5857614, Koss 5222660, Lisiecki 4702407, Thornhill 3981433, Young 3580483, Olson 3426955, and Guyer 3347446 disclose different methods for making a dispensing assembly.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sameh H. Tawfik whose telephone number is (703) 308-2809. The examiner can normally be reached on Tuesday - Friday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (703) 308-2187. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 308-7769 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ST.

May 20, 2003



**EUGENE KIM  
PRIMARY EXAMINER**